

**REMARKS**

Applicants gratefully acknowledge the Examiner's entry of the previously submitted amendments to the specification and claims, as well as the withdrawal of the rejection of claims 1-8, 13-15, 28-35, 40-47, 52-57, 62-66 and 71-77 under 35 U.S.C. § 102(b) as being anticipated by Melius et al. and the withdrawal of the formal rejection. Claims 1-23 and 26-85 stand rejected under 35 U.S.C. § 102(b). Claims 24-25 stand rejected under 35 U.S.C. § 103(a).

Claims 16 and 17 are amended herein. Claim 16 is amended to recite "a stabilizing agent." Support for this amendment is found on page 8, lines 17 et seq. of the present specification, wherein Applicant provides "[o]ptionally, the polymer is combined with a stabilizing agent" and further provides specific examples of suitable stabilizing agents. Claim 17 is amended to clarify that the AUL value is "at 0.3 psi." Support for this amendment can be found on page 8, lines 11-12 of the specification, where the AUL pressure is established. Therefore, no new matter is added by these amendments. Further, the amendments do not raise any new issues, and the amendments are believed to place the application in condition for allowance or, alternatively, reduce issues on appeal. Accordingly, Applicant respectfully requests entry of the amendments.

Claims 1-85 remain pending in the application. Applicant respectfully requests reconsideration and allowance of each pending claim in view of the following remarks.

**Rejection under 35 U.S.C. § 102**

**A. Melius, et al. (5,601,542)**

Claims 16-19 and 26 remain rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,601,542 to Melius, et al. ("Melius"). Specifically, the

Examiner indicates that "in response to Applicant's argument that the reference fails to show certain features of Applicant's invention, it is noted that the features upon which Applicant relies (i.e., an AUL value) are not recited in the claims." Office Action, page 12. Although Applicant believes the claims are not anticipated because the prior art does not disclose each and every element of the claim, Applicant has nevertheless amended the claims to further the prosecution of this case. In particular, claim 16 is amended to specifically include the limitation of "a stabilizing agent" and claim 17 clarifies the AUL value. Therefore, Applicant believes that the rejection is rendered moot by the amendments.

Accordingly, Applicant respectfully requests reconsideration and allowance of pending claims 16-19 and 26.

B. Chmielewski (5,891,120)

Claims 1-23 and 26-81 are rejected under U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,891,120 to Chmielewski ("Chmielewski"). The Examiner correctly recognizes that the reference is silent with regard to the Gel Integrity Index values specifically recited in the claims. However, the Examiner asserts that these values would be inherent in the claimed composition. Applicant respectfully traverses the Examiner's basis for rejection for at least the following reasons.

Anticipation requires that "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (quoting *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631 (Fed. Cir. 1987)). To establish inherency it is not enough to show that a certain result or characteristic may occur or be present in the prior art. Instead, it is necessary to provide extrinsic evidence that "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." MPEP 2112; See also MPEP

2131.01 (citing *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). Probabilities or possibilities are not enough to establish inherency. *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999); see also *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

Here, although the Examiner recognizes that the reference is silent with regard to the stated Gel Integrity Index values, no extrinsic evidence is provided to show that such values would be inherent in the cited reference. Instead, only a speculation of inherency is made. Moreover, such speculation is directly contradicted by extrinsic evidence present by Applicant. In particular, Applicant cites U.S. Patent No. 5,843,059 to Niedermeyer, et al. ("Niedermeyer"), which discloses a number of superabsorbent materials and their Gel Integrity Index values. Specifically, Table 2 in columns 17-18 discloses the Gel Integrity Index values for the tested superabsorbent polymers, which range from 392.4 kg mm to 2084.3 kg mm. Accordingly, Applicant submits that Gel Integrity Index is not an inherent property of a superabsorbent polymer, but rather one that may be varied to specification.

Further, as noted in Applicant's response to the previous Office Action, slight changes in the chemical structure of a superabsorbent polymer will produce significant changes in the properties (e.g. Gel Integrity Index). Therefore, a superabsorbent manufacturer can design the chemical structure of a superabsorbent to achieve specified properties (e.g. to have a Gel Integrity Index of less than about 500 kg mm). Thus, a polymer bearing some similar physical features to another polymer may still differ in other physical features. The superabsorbent properties recited in the present claims are Gel Integrity Index ("GII") and Absorbency Under Load ("AUL"). The basis for this is that Applicant "unexpectedly discovered that superabsorbent polymers having a Gel Integrity Index of less than about 500 kg mm provide superior absorbency characteristics. Any superabsorbent polymer having the physical characteristics recited herein are suitable." Page 7, line 24 - page 8, line 2. Additionally, Applicant discovered that "[t]he present invention is unexpectedly effective with superabsorbent polymers

having a low AUL." Page 8, lines 10-11. As noted above, the Chmielewski reference is silent as to the GII of the superabsorbent. Chmielewski is similarly silent as to the AUL of the superabsorbent, and any other physical properties of a superabsorbent material. Rather, Chmielewski discloses an absorbent product wherein the AUL of the *absorbent structure* (comprising both SAP and cellulosic fibers) is not less than 12 g/g. The AUL of the absorbent structure described in the reference should not be compared to the AUL of the superabsorbent recited in the present claims. Thus, even if the Examiner were to provide evidence of inherency, such evidence would be rebutted by the unobvious differences between Applicant's claimed subject matter and the cited reference.

In view of the foregoing, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection and allow pending claims 1-23 and 26-81.

#### **Rejections under 35 U.S.C. § 103**

To establish a *prima facie* case of obviousness, three basic criteria must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, (2) there must be a reasonable expectation of success, and (3) the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP § 2142. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Applicant respectfully submits that the burden of establishing a *prima facie* case of obviousness has not been met by the Examiner in this case. Moreover, even if a *prima facie* case of obviousness was established, it would be rebutted by secondary evidence of nonobviousness.

A. Melius in view of Roberts

Claims 24-25 are rejected under U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,601,542 to Melius, *et al.* as applied to claim 16, and further in view of U.S. Patent No. 3,875,942 to Roberts, *et al.* ("Roberts").

In view of the foregoing amendments, Applicant respectfully submits that this rejection is rendered moot. Melius fails to teach, or in any way suggest, an absorbent article that has a GII of less than about 500 kg mm and a stabilizing agent as recited by claim 16, or an AUL of 25 g/g at 0.3 psi as recited by claim 17. Dependent claims 24-25 also include the limitations. Roberts fails to remedy the deficiencies of Melius because it also fails to teach or suggest these properties. Therefore, the references in combination do not teach or suggest all the elements of the claims, and do not support a *prima facie* case of obviousness. Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw these rejections and allow the pending claims.

B. Chmielewski in view of Roberts

Claims 24-25 are rejected under U.S.C. § 103(a) as being unpatentable over by U.S. Patent No. 5,891,120 to Chmielewski as applied to claim 16, and further in view of U.S. Patent No. 3,875,942 to Roberts, *et al.*

In view of the foregoing arguments, Applicant submits that Chmielewski fails to inherently disclose an absorbent article comprising an absorbent article that has a GII of less than about 500 kg mm, as recited by claim 16. Dependent claims 24-25 depend from claim 16 so they also include this element. The Roberts reference fails to overcome the fundamental deficiency of the Chmielewski patent because it also fails to teach or suggest the recited physical properties of the superabsorbent. Therefore, the prior art references in combination do not teach or suggest all the claim limitations, and do not support a *prima facie* case of obviousness. Accordingly, Applicant respectfully requests

that the Examiner reconsider and withdraw these rejections and allow the pending claims.

CONCLUSION

For at least the reasons outlined above, Applicant respectfully submits that the application is in condition for allowance. Favorable reconsideration and allowance of the pending claims are respectfully solicited. Should there be anything further required to place the application in better condition for allowance, Examiner Anderson is invited to contact Applicant's undersigned representative at the telephone number listed below.

Respectfully submitted,

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